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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,451	09/21/2001	Marc O. Schurr	06530.0276-00000	2507
7590 06/10/2004			EXAMINER	
Finnegan, Henderson, Farabow Garrett & Dunner, L.L.P. 1300 I Street N.W. Washington, DC 20005-3315			ROBERTS, PAUL A	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/957,451

Applicant(s)

SCHURR ET AL.

Examiner

Paul A Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 120-163 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 120-163 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/19/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The amendment filed 3/15/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: there is no support for a bridge in the original disclosure, nor is there support for an anti-rotation structure in figures 6a-6b. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 158-163 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure has no support for a bridge or rotation prevention member.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, 7, 120-122, 130-132, 134, 135, 136, 143-145, 147, -155, and 157 are rejected under 35 U.S.C. 102(b) as being anticipated by MacNeill 4,346,869.

Regarding claims 1-3, 120-122, 135, and 136 MacNeill discloses a tube clamp containing: a first arm 12, and a second arm 14 that is disposed opposite to the first arm and having an end connected to an end of the first arm to define an opening. The arms are capable of securing tissue between the arms. The anchoring portion is element 32.

Regarding claims 5, 131, 132, 144, 145, 154, and 155, element 50 is the gripping tab.

Regarding claims 7, 134, 147, and 157, the first and second arms substantially form a U-shape.

Regarding claims 130, 143, and 153, the arm 14, contains a portion that tapers, curving away from the gap.

Regarding claims 148 and 149, the projection is element 46.

Regarding claim 150, the projection includes a barb.

Regarding claim 151, element 52 is the second projection.

Regarding claim 152, the first and second projections are located opposite one another.

4. Claims 1, 6, 120, and 133 are rejected under 35 U.S.C. 102(b) as being anticipated by Klieman et al. (Kliemna) US 4,188,953. Klieman discloses a clip with two arms that define a gap therebetween. The clip may be made of bioabsorbable material.

5. Claims 120, 123-127, 135, 136-139, 140, 146, 148, and 156 rejected under 35 U.S.C. 102(b) as being anticipated by Jewusiak US 4,424,810.

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Regarding claims 120, 135, 136, 146, 148, and 156, Jewusiak discloses a 2-armed clip that has a projection in the gap between the 1st and 2nd arms. The clip is absorbable. The projection is element 15. Element 15 can be alternatively interpreted as the anchoring portion.

Regarding claims 123, 125, 126, 127, 137-140, the anchoring portion has two projections 15 & 25 and the projections are located opposite each other.

Regarding claims 124 and 138, the projection includes a portion in the shape of a barb. Element 15 is in the shape of a barb.

6. Claims 4, 128, 129, 141, and 142 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerwin et al. (Cerwin) US 4,449,531. Cerwin discloses a clip with an anchoring portion and a fixation hole. The anchoring portion has a pin.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4345600 A	Purse-stringer
US 4387489 A	Clasp for locking a ligature loop
US 4519392 A	Hemostasing muscle clips for needleless surgery
US 6428548 B1	Apparatus and method for compressing body tissue


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Roberts
Paul.Roberts@uspto.gov
06/02/04



DAVID O. REIP
PRIMARY EXAMINER